

R<sup>4</sup> denotes -C<sub>6</sub>H<sub>4</sub>-(CH<sub>2</sub>)<sub>n</sub>-NR<sup>5</sup>R<sup>5</sup>,

R<sup>5</sup>, R<sup>5</sup> each, independently of one another, denote A,

A denotes alkyl having 1 C atom,

Hal denotes Cl, and

n denotes 1.

Applicants respectfully disagree with the restriction. The Patent Office has not established that it would pose a serious burden on the Examiner to search all the groups. No further, or only a minimal, search would be necessary to allow the remaining groups once the elected claims are allowed.

For example, the claims of groups IV and VI (claims 12, 13 and 15) are directed to products comprising the compound product of the elected group. Thus if the elected compound products themselves are patentable, products comprising the same compound products should be patentable as well.

Furthermore, the articles of product claims 12, 13 and 15 are combinations of the compound products of the elected claims and other components. As such, it is respectfully submitted that the compound products of the elected claims and the combination of said compound products and other components are related as combination-subcombination. Since they are related as combination-subcombination, the standard for requiring restriction herein is not met.

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e. separate classification, status, or field of search. See MPEP §808.02. If it can be shown that a combination, as claimed

(1) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

(Emphasis added.) (M.P.E.P. §806.05(c))

It is submitted that the first requirement for two-way distinctness is not established herein. The combination does require the particulars of the subcombination. The products of claims 12, 13 and 15 all require the exact same compound products of the same scope as the subcombination claims of the elected group. To this end, the combination claims are even dependent upon the subcombination-product claims and the subcombination-products are an essential distinguishing feature of the combination-products.

It is respectfully submitted that when the relationship between the claimed subject matter is properly characterized, there is no basis for restriction herein. Thus, the restriction requirement should be withdrawn with regard to these product claims 12, 13 and 15 at least.

As to the Election of Species Requirement, the Examiner, applicants remind the Examiner in accordance with M.P.E.P. 803.02, that should no prior art be found which renders the invention of the elected species unpatentable, the search of the remainder of the generic claim(s) should be continued in the same application. Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. See MPEP 803.02 in accord.

Additionally, applicants bring the attention of the Examiner to MPEP § 821.04, Rejoinder, which states that “if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims [both process of making and using] which either depend from or include all the limitations of the allowable product will be rejoined.” If the restriction requirement is maintained at this point regarding the claims of groups II, III, and V (claims 9, 10, 11, 14 and 16), the rejoinder of these non-elected claims is respectfully requested at the proper time in accord with the rejoinder provisions of the MPEP.

No fee is believed to be due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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